

REMARKS

In the Final Office Action mailed on April 24, 2006, the Examiner rejected claims 1-31. In lieu of filing a Notice of Appeal, the Applicants are filing a Request for Continued Examination (RCE) pursuant to 37 C.F.R. § 1.114, along with this Preliminary Amendment. By this paper, claims 1, 15, and 28-30 have been amended to more clearly set forth the recited subject matter. No new matter has been added. Applicants respectfully request reconsideration of the present application in view of the remarks set forth below. Applicants believe that all pending claims, as amended, are in condition for allowance.

Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 1-8, 12, 15-18, and 21-31 under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. (U.S. Patent No. 7,035,657, hereafter referred to as “the Chen reference”) in view of Lee (U.S. Publication No. 2004/0008660, hereafter referred to as “the Lee reference”); rejected claims 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over the Chen reference in view of the Lee reference as applied to claims 1 and 7 above and in further view of Yuhara et al. (U.S. Publication No. 2004/0192189, hereafter referred to as “the Yuhara reference”); rejected claims 10, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over the Chen reference in view of the Lee reference as applied to claims 1 and 7 above and in further view of Chang et al. (U.S. Patent No. 6,487,406, hereafter referred to as “the Chang reference”); rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over the Chen reference in view of the Lee reference as applied to claims 15 and 16 above and in further view of Zhigang (U.S. Publication No. 2005/0014489, hereafter referred to as “the

Zhigang reference”); and rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the Chen reference in view of the Lee reference as applied to claims 15 and 16 above and in further view of Ahmed et al. (U.S. Publication No. 2003/0174688, hereafter referred to as “the Ahmed reference”). Applicants respectfully traverse these rejections.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Second, in presenting a Section 103 rejection, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed.

Cir. 2002). “Broad conclusory statements standing alone are not ‘evidence’.” *In re Kotzab*, 55 U.S.P.Q. 2d 1314, 1317 (Fed. Cir. 2000). Thus, when prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification *other than the hindsight* gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, the Federal Circuit has warned that the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See In re Dembiczak* 50 U.S.P.Q. 2d 52 (Fed. Cir.1999). (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir.1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease which the invention can be understood may prompt one to employ such hindsight. *See id.*

Third, the Federal Circuit has held that if proposed modification renders the reference being modified *inoperable for its intended purpose*, the reference teaches away from a proposed modification. *See In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984; *see also In re Schulpen*, 157 U.S.P.Q. 52, 54 (C.C.P.A. 1968). More recently, the Federal Circuit has again reiterated this tenet of law stating that “[i]f when combined, the references ‘would produce a seemingly inoperative device,’ then they teach away from their combination.” *Tec-Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 U.S.P.Q. 1294, 1298 (Fed. Cir. 1999) *citing In re Sponnoble*, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1969).

Improper Combination - Lack of Objective Evidence of Reasons to Combine

As described above, the Examiner combined the Chen and Lee references in rejecting independent claims 1, 15, and 28. However, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Chen and Lee references to reach the present claims. As summarized above, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. at 1430. In the present rejection, the Examiner combined the Chen and Lee references based on the *conclusory and subjective statement* that:

it would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen et al. with the transceiver unit is directly couple to the undedicated public network in order for the wireless IP network system to save communication resources by eliminating communication components or communication links which would allow the network to quickly receive a multimedia group call session request from a group of target communication devices and quickly deliver the multimedia group call session to the target communication devices, as taught by Lee.

Office Action, page 3. This statement, however, is not evidence nor does it point to any place in either of the references that provides any evidence of a motivation to combine the references.

Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references or remove the foregoing rejection under 35 U.S.C. § 103.

Improper Combination – Impermissible Hindsight Reconstruction

In addition, Applicants also assert that there is no motivation to combine the Chen and Lee references as posited by the Examiner. As set forth in the Final Office Action, the Examiner proposes replacing the base station 204, the base station controller (“BSC”) 110, the packet control function (“PCF”) 112, and the packet data serving node (“PDSN”) 106 of the Chen reference with the wireless internet network 20 of the Lee reference. Final Office Action, page 3. As described above, in support of this combination, the Examiner alleges that the motivation for this combination rests in a desire to “save communication resources [of the Chen reference] by eliminating communication components or communication links which would allow the network to quickly receive a multimedia group call session request from a group of target communication devices.” *Id.* As described further below, however, Applicants respectfully assert that neither reference supports this alleged motivation to combination, and, as such, the Examiner has employed impermissible hindsight to arrive at the present rejection.

Applicants respectfully assert that there is no evidence in the Chen reference that the “motivation” provided by the Examiner is even a problem. In particular, the Chen reference never mentions that speeding up the receipt of call sessions requests is even desirable. Beyond this, there is *absolutely no evidence* that making the Examiner’s proposed modifications would even speed-up the system disclosed in the Chen reference. In fact, Applicants believe that replacing the disclosed *dedicated components* (e.g., the BCS, PCF, and PDSN) with the *generic* wireless internet network 20 would *actually slow down performance* of the group calling system

disclosed in the Chen reference. As such, the “motivation” posited by the Examiner is far more likely to teach against the combination than to motivate one of ordinary skill in the art to make the combination.

For at least this reason, Applicants respectfully assert that there is no motivation to combine the Chen and Lee references. Rather, this unlikely combination suggests that the Examiner has used the structure of Applicants’ own invention as a basis from which to selectively pick and choose various elements of the cited references in an attempt to cobble together obviousness rejections of independent claims 1, 15, and 28. This action, however, is clearly improper. *See In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991) (*stating* “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, *using the applicant’s structure as a template* and selecting elements from references to fill the gaps” (emphasis added)). Accordingly, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness against independent claims 1, 15, and 28 and request withdrawal of the pending Section 103 rejection.

Improper Combination – Reference rendered inoperable for its intended purpose

Applicants also respectfully assert that there is no motivation to combine the Chen and Lee references, because modifying the Chen reference, as proposed by the Examiner, would render the Chen reference inoperable for its intended purpose. Towards this end, Applicants remind the Examiner that there is no motivation to combine two references if “when combined, the references ‘would produce a seemingly inoperative device’” *Tec-Air Inc. v. Denso*

Manufacturing Michigan Inc., 52 U.S.P.Q. 1294, 1298 (Fed. Cir. 1999) *citing In re Spinnoble*, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1969).

The Chen reference discloses a *structured* group communication system 100 for “multicasting media to the group of target communication devices to save network resources.” Chen, abstract, lines 1-5. As illustrated by Figs. 1 and 2 of the Chen reference, the system 100 includes a mobile station 206 that transmits data wirelessly across an air interface 208 to a base station 204. *See also* Chen, paragraph 22, lines 1-8. This received data is then transmitted from the base station 204 to a base station controller (“BSC”) 110. *See* Chen, Figs. 1 and 2. The received data then travels from the BSC 110 to the packet control function (“PCF”) 112 then to the packet data switching node (“PDSN”) 106, then to the IP network 108, and then to the group call server 102. *See* Chen, Fig. 1; *see also* paragraph 19.

Each link in this *structured transmission system* performs a vital role in organization and control of the group call. *See* Chen, paragraph 19. For example, the base station 204 processes registration information from the mobile station 206 and the PCF 112 controls routing of packets across the IP network 108. *See* Chen, paragraph 19 and paragraph 25. If, as the Examiner proposes, the base station 204, the BSC 110, the PCF 112, and the PSDN 106 were all removed and replaced with the wireless internet network 20 of the Lee reference, the system 100 would simply *not function*, much less function as intended. As described above, each component of the system 100 performs a specific task, removing all of those components and replacing them with

the generic wireless internet network, (as the Examiner suggests) will simply result in an inoperable system.

In further example, the wireless internet network 20 of the Lee reference is never described as being able to perform the functions of the BSC 110. In addition to those features described above, the wireless internet network 20 is also unable to bind mobile devices with a multicast IP address or to map registered mobile devices to an IP multicast address through a shared channel (multicasting is never mentioned in the Lee reference). Chen, paragraphs 43-44. For at least this reason (amongst a multitude of further possible examples), replacing the base station 204, the BSC 110, the PCF 112, and the PSDN 106 of the Chen reference with the wireless internet network 20 of the Lee reference would clearly make the Chen reference, as modified, inoperable for its intended purpose. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection and allowance of claims 1, 15, and 28, as well as the claims that depend therefrom.

Claims 9 and 11

Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with regard to claims 9 and 11. As stated above, the Examiner rejected claims 9 and 11 as obvious over the Chen reference in view of the Lee reference as applied to claims 1 and 7 above and in further view of the Yuhara reference. However, as described above, the Chen reference clearly does not disclose those claim features attributed to it by the Examiner. In view of this deficiency, the Examiner's Section 103 rejections of claims 9 and 11, which are based

upon the Examiner's mistaken interpretation of the Chen reference, cannot establish a *prima facie* case of obviousness. As such, Applicants respectfully request withdrawal of the Section 103 rejections of claims 9 and 11.

Claims 10, 13, and 14

Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with regard to claims 10, 13, and 14. As stated above, the Examiner rejected claims 10, 13 and 14 as obvious over the Chen reference in view of the Lee reference as applied to claims 1 and 7 above and further in view of the Change reference. However, as described above, the Chen reference clearly does not disclose those claim features attributed to it by the Examiner. In view of this deficiency, the Examiner's Section 103 rejections of claims 10, 13, and 14, which are based upon the Examiner's mistaken interpretation of the Chen reference, cannot establish a *prima facie* case of obviousness. As such, Applicants respectfully request withdrawal of the Section 103 rejections of claims 10, 13, and 14.

Claim 19

Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with regard to claim 19. As stated above, the Examiner rejected claim 19 as obvious over the Chen reference in view of the Lee reference as applied to claims 15 and 16 above and in further view of the Zhigang reference. However, as described above, the Chen reference clearly does not disclose those claim features attributed to it by the Examiner. In view of this deficiency, the Examiner's Section 103 rejections of claim 19, which are based upon the Examiner's

mistaken interpretation of the Chen reference, cannot establish a *prima facie* case of obviousness.

As such, Applicants respectfully request withdrawal of the Section 103 rejections of claim 19.

Claim 20

Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with regard to claim 20. As stated above, the Examiner rejected claim 20 as obvious over the Chen reference in view of the Lee reference as applied to claims 15 and 16 above and in further view of the Ahmed reference. However, as described above, the Chen reference clearly does not disclose those claim features attributed to it by the Examiner. In view of this deficiency, the Examiner's Section 103 rejections of claim 20, which are based upon the Examiner's mistaken interpretation of the Chen reference, cannot establish a *prima facie* case of obviousness. As such, Applicants respectfully request withdrawal of the Section 103 rejections of claim 20.

Payment of Fees and Authorization for Extensions of Time

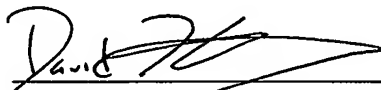
The Commissioner is authorized to charge the requisite fee for the RCE (\$790.00) to the attached PTO-2038. The Commissioner is authorized to charge the requisite fee for the one month extension of time (\$120.00) to Deposit Account No. 06-1315; Order No. LUCW:0002. In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims 1-31. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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